UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte NEAL A. KRAWETZ

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Appeal 2009-011319
Application 09/975,815
Technology Center 2400

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Before ALLEN R. MacDONALD, KALYAN K. DESHPANDE and
BRUCE R. WINSOR, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-34. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim(s)

Exemplary independent claim 1 under appeal reads as follows:

1. A method for secure data transmission, comprising:

generating a character string at a sender for each data packet associated with the secure data transmission;

generating a hash key using the character string and a private key, wherein the hash key is different for each data packet associated with the secure data transmission;

encrypting a data packet associated with the secure data transmission using the hash key; and

transmitting an identification key associated with the sender, the character string, and the encrypted data packet from the sender to a recipient.

Rejections on Appeal

1. The Examiner rejected claims 1-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

2. The Examiner rejected claims 1, 2, 4, 5, 7, 8, 11, 12, 14, 15, 19, and 22-25 under 35 U.S.C. § 102(e) as being anticipated by Roberts (US 6,931,128 B1).

3. The Examiner rejected claims 3, 6, 9, 10, 13, 16-18, 20, 21, and 26-34 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Roberts and Bowman (US 6,751,736 B1).

Appellant's Contentions

1. Appellant contends that the Examiner erred in rejecting claims 1-34 under 112, first paragraph, because:

> Appellant submits that one skilled in the art would recognize that the variable used to generate the hash key 64, namely the character string 54, is changed to generate a hash key 64 that "changes with each transmitted, data packet" as expressly disclosed on page 8, in lines 25-27, of the originally-filed disclosure. For example, at least on page 4 of the originally-filed disclosure, it is stated that "the string generator randomly generates and stores the character string," and that the character string is hashed with the private key to generate the hash key (page 4, lines 19-33). Moreover, one skilled in the art would recognize that the encrypted data packets are associated with the secure transmission.

(App. Br. 7).

2. Appellant contends that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(e) as being anticipated, because:

> Claim 1 recites, inter alia, "transmitting an identification key associated with the sender, the character string, and the encrypted data packet from the sender to a recipient" (emphasis added). On pages 4-5 of the Office Action, Appellee appears to assert that Roberts discloses this limitation by "transmitting an identification key (SPI)." However, in Col. 9, line 65 through Col. 10, line 7, Roberts states:
>
>> A Secure Parameter Index (SPI) is a 96 bit (12 byte) bit sequence that is unique to the second computer system, The SPI may be included to ensure compatibility with the Encapsulation Security Payload (ESP) protocol of the Internet Protocol Security (IPSec) protocol ... The data packet 204 is then transmitted to the second computer system (act 409) for decryption by the decryption device 202.

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> Therefore, the Secure Parameter Index (SPI) of Roberts
> appears, to be associated with the second computer, i.e., the
> receiving computer, and does not appear to be "associated with
> the sender" as recited in Claim 1. For at least this reason,
> Roberts does not appear to anticipate Claim 1.

(App. Br. 8)(emphasis omitted).

     3.   Further, as to the rejections of claims 11 and 17 under 35 U.S.C. § 102(e) and claim 27 under 35 U.S.C. § 103(a), Appellant contends that the Examiner erred for similar reasoning as to claim 1. (App. Br. 9: last full paragraph; 10: third full paragraph; and 11-12: bridging paragraph).

     4.   Lastly, Appellant contends that the Examiner also erred in the new rationale presented for the first time in the Answer at page 26, lines 7-19, because:

> [I]n support of the rejection under 35 U.S.C. §102(e) the
> Appellee generally states on page 26 of Examiner's Answer for
> the first time during prosecution that the "identifying label" of
> *Roberts* meets the claim limitation of an identification key
> associated with the sender, that the "label" being concatenated
> with the random seed and transmitted to the second computer
> system meets the claim limitation of transmitting an
> identification key associated with the sender, and that
> disclosing "the first and second computer negotiating a
> parameter expiry identifying the valid lifetime of the master
> secret" meets the claim limitation of an identification key
> associated with the sender. Appellant respectfully submits that
> in each instance, the alleged "key" identified by the Appellee is
> simply not associated with the sender as claimed and that the
> above-referenced purported disclosure of *Roberts* in no way
> identifies the sender to the receiving computer.

(Reply Br. 8).

Issues on Appeal

Whether the Examiner has erred in rejecting claims 1-34 under 35 U.S.C. § 112, first paragraph, because the subject matter added to the claims by amendment would have been recognized as inherent by persons of ordinary skill? Whether the Examiner has erred in rejecting 1-34 as being anticipated or obvious because Roberts fails to disclose claim limitation(s)?

PRINCIPLES OF LAW

MPEP 2163.07(a)

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

ANALYSIS

We agree with the Appellant's above contention 1. We conclude that persons of ordinary skill would necessarily arrive at the claimed invention upon implementation of "changes with each transmitted, data packet" as expressly disclosed on page 8, lines 25-27, of Appellant's originally filed written description. At most, Appellant's claims fail to comply with the

requirements of 37 C.F.R. § 1.75(d)(1), and an objection might be appropriate based on failure to comply therewith.

As to Appellant's above contentions 2-4, we agree with Appellant.

Therefore, Appellant has established that the Examiner erred with respect to the rejections of claims 1-34.

CONCLUSIONS

(1) Appellant has established that the Examiner erred in rejecting claims 1-34 as failing to comply with 35 U.S.C. § 112, first paragraph.

(2) Appellant has established that the Examiner erred in rejecting claims 1, 2, 4, 5, 7, 8, 11, 12, 14, 15, 19, and 22-25 as being anticipated under 35 U.S.C. § 102(b).

(3) Appellant has established that the Examiner erred in rejecting claims 3, 6, 9, 10, 13, 16-18, 20, 21, and 26-34 as being unpatentable under 35 U.S.C. § 103(a).

(4) On this record, claims 1-34 have not been shown to be unpatentable.

DECISION

The Examiner's rejections of claims 1-34 are reversed.

REVERSED

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